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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,975	05/02/2006	Stuart Cook Niven	11/2-22976/A/MA 2236/PCT	7546
324	7590	06/25/2009	EXAMINER	
JoAnn Villamizar			FAISON GEE, VERONICA FAYE	
Ciba Corporation/Patent Department				
540 White Plains Road			ART UNIT	PAPER NUMBER
P.O. Box 2005				
Tarrytown, NY 10591			1793	
			NOTIFICATION DATE	DELIVERY MODE
			06/25/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/577,975	NIVEN ET AL.	
	Examiner	Art Unit	
	VERONICA FAISON GEE	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 March 2009.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3,6,8-12,14-18 and 21-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3,6,8-12,14-18 and 21-23 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Response to Amendment

Claims 1 and 2 have been amended, claim 23 has been added and claims 4, 5, 13, 19 and 20 are canceled. Hence, claims 1-3, 6, 8-12, 14-18 and 21-23 are pending in the application.

Applicant's arguments are persuasive to the extent that the over Ryter has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6, 8-12, 14-16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al (US Patent 5,944,881).

Mehta teaches ink colored dye, a colored pigment, and a fluorescent pigment (abstract). Ink is provided comprising a colored pigment, a fluorescent pigment, a colored dye, and a liquid carrier acts as a solvent for the dye (col. 1 line 67- col. 2 line 3). The liquid carrier comprises a blend of aliphatic long chain oil and a long chain unsaturated fatty acid wherein some of the preferred aliphatic oils include soybean oil and peanut oil (col. 2 lines 11-14). Soybean oil is most preferred. The long chain oil component preferably makes up from about 5 to about 40% by weight of the ink. The ink also preferably includes from about 4 to 10% by weight of a thickener (col. 3 lines

48-64). The ink is printed onto a security document by a letterpress printing process (col. 4 lines 1-2). Security ink was prepared by combining the following material: the red base dye was dissolved into the linoleic acid by mixing for thirty minutes at 100°C. The fluorescent base, soybean oil, and black base were then added to the mixture. The temperature was then raised to 120°C., and the thickener was added. The components were mixed for forty minutes at 120°C and then drained into container (col. 4 lines 45-col. 5 line1). The reference remains silent to the type of pigment present in the composition. However it is the position of the Examiner that any pigment conventionally known for the type of ink of the reference and would include disazo and naphthol pigments absence tangible evident to the contrary.

Mehta et al and the claims differ in that Mehta et al does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Mehta et al overlap the instantly claimed proportions and therefore are considered to establish a *prima facie* case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al (US Patent 5,944,881) as applied to claims 1, 3, 6, 8-12, 14-16 and 23 above, and further in view of Ohnishi (US Patent 5,328,504).

Mehta et al is described above, but fails to teach the specific solvent dye.

Ohnishi teaches an ink composition oil-soluble dye comprising Solvent Yellow 7 and 14, Solvent Red 19, 23, 24, 25, 26, 27, 49, 52 and Solvent Blue 2, 35 and 36.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced Solvent Red 49 with Solvent Red 19, Solvent Red 23, Solvent Red 24, Solvent Blue 35, Solvent Blue 36, Solvent Yellow 7 and Solvent Yellow 14 because the substitution of art recognized equivalents as shown by Ohnishi would have been within the level of ordinary skill in the art.

Claims 17, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al (US Patent 5,944,881) as applied to claims 1, 3, 6, 8-12, 14-16 and 23 above, and further in view of Ohtomo (US Patent 5,256,772).

Mehta et al is described above, but fails to teach organic pigment is coated with a printing ink varnish.

Ohtomo teaches a monoazo lake pigment which is obtained by subjecting a coupling reaction a diazo component mixture containing a naphthalene-based or benzene-based amine having a soluble group (abstract, col. 1 lines 48-65). The reference further teaches that the monoazo lake pigment may be used as a colorant for

an offset ink (lithographic ink), a gravure ink and a coating (col. 1 lines 8-14). The monoazo lake pigment may also be treated with an additive or treating agent such as aliphatic amines, water-soluble resins, surfactants, etc (col. 4 lines 54-56). Ohtomo further teaches that the resultant wet cake of the pigment may be formed into a base color after a flushing step in which the wet cake is directly mixed with a varnish for an ink or resin for coating composition. The wet cake may be dried and milled to a proper size to form a pigment powder (col. 4 line 65-col. 5 line 5). Therefore it would appear that the pigment is coated with varnish as the pigment and varnish are mixed, dried and milled together, absence tangible evidence to the contrary.

Therefore it would have been obvious to one of ordinary skill in the art to use the pigment as taught by Ohtomo in the composition of Mehta et al as Mehta et al broadly discloses colored pigment and that the ink composition are similar.

Response to Arguments

Applicant's arguments with respect to the rejection(s) of claim(s) 1-6, 8-12 and 14-22 under 102(e) and 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mehta et al (US Patent 5,944,881).

Applicant argues that Mehta does not disclose the pigment/solvent dye ratio set forth in claim 1.

The Examiner respectfully disagrees. Although there is no specific example that exemplifies the claim ratio, the reference discloses ranges that would overlap applicant's claimed ratio.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed. Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976); *In re Lamberti* 192 USPQ 278 (CCPA 1976); *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Preda* 159 USPQ 342 (CCPA 1968); *In re Van Mater* 144 USPQ 421 (CCPA 1965); *In re Jacoby* 135 USPQ 317 (CCPA 1962); *In re LeGrice* 133 USPQ 365 (CCPA 1962).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is

(571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit 1793

/Veronica Faison-Gee/
Examiner, Art Unit 1793